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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/996,454 | 11/20/2001 | Thomas Wirycz | 7189 | 2430 |
| 29602 | 7590 | 06/22/2006 | | |
| JOHNS MANVILLE INTERNATIONAL, INC. 717 SEVENTEENTH STREET DENVER, CO 80202 | | | EXAMINER GOFMAN, ANNA | |
| | | | ART UNIT | PAPER NUMBER |

1771

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,454

Applicant(s)

WIRYCZ ET AL.

Examiner

Anna Gofman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3, 5-20 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/02
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund (US 6,291,011) in view of Melber (US 4,902,722).

Edlund discloses a method of producing a fiberglass wallcovering similar to the present invention (claim 1). Edlund does not teach applying a second image coating of expandable material. Melber teaches a syntactic foam material that can be applied to any suitable medium to provide graphic representations (col.2 lines 38-48), including wallcovers and fiberglass (col.7 lines 16-30). The foam of Melber comprises polymeric binder and expandable microspheres (col.3 lines 9-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the image

coating step of Melber in addition to the processing steps of Edlund in order to provide a graphic representation to the wallcovering, as taught by Melber. With regard to claims 2-3 and 5-15, see the dependent claims of the Edlund reference. With regard to claim 16, Melber discloses using acrylic latex binder (example 1). With regard to claims 17-18, Melber discloses adding various modifiers to the material (col.3 lines 24-28).

Additionally, Melber discloses the foam must be stable (col.1 lines 33-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add defoaming agent in order to better stabilize the expandable material, as desired by Melber. With regard to claim 19, Melber discloses the foam material includes pigment (col.3 lines 11-12). With regard to claim 20, Melber discloses using several different printing methods (col.6 lines 55-57). With regard to claims 23-24, Melber teaches the expansion takes place upon the application of heat (col.5 lines 1-5).

4. Claims 1-3, 5-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund (US 6,291,011) in view of Schwartz et al. (US 4,433,022).

Edlund discloses a method of producing a fiberglass wallcovering similar to the present invention (claim 1). Edlund does not teach applying a second image coating of expandable material. Schwartz et al. teach a three-dimensional printed ceiling board facing material in which a foam-coated fabric is selectively printed with an expandable print paste. Upon heating the expandable coating is substantially increased in size and bonded to the coated substrate (abstract). The print pastes contain microspheres (col.3 lines 59-60). It would have been obvious to one having ordinary skill in the art at the

time the invention was made to use the image coating step of Schwartz et al. in addition to the processing steps of Edlund, motivated to provide a graphic representation to the wallcovering, as taught by Schwartz et al. Edlund teaches that the glass fabric is a woven fabric (col.2 lines 58-59). In Table 1 Edlund teaches 65-75% of potato starch, 20-30% of vinyl acetate ethylene copolymer and 2-6% of ammonium zirconium carbonate of dry substance. A rotating screen is used to apply the hydrophobic image which includes a varnish. The hydrophobic mixture may be with or without color pigments. The paints can be water-based or metallic (col.3 lines 55-67 and col.4 lines 1-2). Edlund does not teach a defoamer and thickening agent. Schwartz et al. teach that a defoamer or thickener can be added to the crosslinkable resin or binder (col.4 lines 7-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the defoamer and thickener motivated to stabilize the expandable material, as taught by Schwartz et al.

Response to Arguments

5. Applicant's arguments with respect to claims 1-3, 5-20 and 24 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the material of Edlund is intended to be painted and that it would not have been obvious to have included the foamable layer taught by Melber. Even though the material of Edlund is intended to be painted, this would not preclude one of ordinary skill in the art from providing the foamable coating in order to impart additional design to the material. Further, while Melber uses pre expanded microspheres, Melber teaches at col. 8 that a portion of those can be substituted with the expandable microspheres. With regard to

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the amended transitional phrase, "consisting essentially of", Examiner is construing it to mean "comprising" in the absence of a showing by applicant that the presence of the additional components changes the basic and novel characteristics. Since Melber teaches using both pre expanded and expandable it meets the claim. With regard to the newly amended claims, the use of the transitional phrase, "consisting essentially of" shifts the burden on Applicant to show that the additional components would materially change the basic and novel characteristics of the invention and here, although Applicant states that it would have a negative effect, Applicant has not presented evidence or arguments showing what the effect would be. Also, in the absence of a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as meaning comprising.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Gofman whose telephone number is (571) 272-7419. The examiner can normally be reached on Mon.-Fri. 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anna Gofman
Examiner
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ELIZABETH M. COLE
PRIMARY EXAMINER

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